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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,311

11/12/2003

Ken Rosenblum

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12/11/2007

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT

PAPER NUMBER

3653

MAIL DATE

DELIVERY MODE

12/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,311

Applicant(s)

ROSENBLUM, KEN

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/10/07 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 13, 21 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation "unique code, which is incapable of being reused" is not found anywhere in the specification or disclosure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Bain (US 2005/0021175A1).

As described in **Claims 1-3, 5, 6, 13-17, 19-21, 23, 24, 28 and 29**, Bain discloses an automatic medication dispensing machine (100) having a loading portion facing an enclosed pharmacy floor space, as shown in figure 2, the pharmacy, being to the right of wall (104). Service providers on the right side place filled prescriptions into compartments (152) which are closed by doors (166). A customer keys in a PIN number and phone number at the front console data interface (124) which is mentioned in paragraph 60 as having a keyboard. See also paragraph 111. If the phone number and PIN are verified, and the customer verifies the order listed on the screen, then the dispensing mechanism releases the filled prescription through door (158) to pick up area (140).

Further regarding **Claim 6**, note that Bain discloses that the prescriptions are verified at paragraph 111.

Bain further discloses, as described in **Claim 4**, a bar code reader (78).

Bain also discloses, as described in **Claims 7, 8, 18, 25 and 26**, a speaker (32) and a video device described in paragraphs 20 and 43.

Regarding **Claim 9**, Bain discloses a remote communications means (86) that is described in paragraphs 52-58 that allows delivery of a filled prescription to a customer located outside the store.

Regarding **Claims 10, 27 and 30**, see paragraph 111, which describes the financial transaction that takes place during a dispensing event.

Regarding **Claim 11**, Bain discloses a dispensing mechanism (100), a product delivery chute having a product holding portion (152) and a product holding portion (140) separated by moving door (158).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bain in view of Coughlin et al (US 6,883,681 B1).

Bain discloses the drug will-call system described above.

Williams does not expressly disclose, but with respect to Claim 22, Coughlin discloses shelf storage locations (16) with an infeed conveyor (18) and an outfeed conveyor (21) with a pick and place transporter (22 and 126) that transports items between the storage locations and the infeed and outfeed conveyors.

Williams does not expressly disclose, but with respect to Claim 12, Coughlin discloses a ram assembly (90) for pushing products from the infeed conveyor to the

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transporter, said ram assembly having a sensor (100) that senses when product has been conveyed in front of the ram plate (92). See figures 8-12 and col. 6, lines 16-33. Coughlin also discloses a ram assembly (118) which moves items onto outfeed belt (110). See figures 13-17 and col. 6, line 35-col. 7, line 12.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Coughlin's transporter to transport items from Bain's storage areas to Bains dispensing area and to have incorporated Coughlin's conveyor with ram assembly into Bain's dispensing area. to push items to and from the conveyor to the transporter or vise-versa.

The suggestion/motivation for using Coughlin's transporter would have been to transport items efficiently to and from Bain's storage areas to the dispensing area. The suggestion/motivation for using Coughlin's conveyor with ram assembly in Bain's dispensing area would have been to push items back and forth from the conveyor to the transporter.

Note that one ordinarily skilled in the art would have found it obvious to use a time out based on the output of sensor (100), for example, thus causing ram assembly (90) to clear the dispensed items from the dispensing area, as suggested by Coughlin's ram assemblies (90) and (118).

Also, note that one ordinarily skilled would have found it obvious to make Bain's compartments more horizontal so as to work with Coughlin's transporter.

See also Coughlin at col. 13, lines 1-5, which describes the infeed conveyor moving several items back from the ram leaving only one item in front of the ram during

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a particular event, such as receiving a command to load an item during a storing routine. This can be construed as further motivation for one ordinarily skilled to cause items left on the outfeed dispensing conveyor to be cleared and restored in one of the storage compartments.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart et al (US 7,006,893 B2) in view of Bain.

Hart discloses incorporating several different drug vending machines in a network (320) or (9010), one machine (20, 124, 130, 132, 182, 324, 582 or 9044) dispensing prescription drugs in containers already labeled (see figure 1a, for example), the other machine (1650) dispensing drugs in containers that have been automatically labeled by the vending machine itself. See Hart, figures 35, 36 and 110a and col. 46, line 10- col. 48, line 28.

Hart does not expressly disclose, but Bain discloses the will-call system described above.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated Bain's will-call system into the network of Hart, having a first will-call vending machine that dispenses drugs in containers that have been pre-labeled and a second vending machine that dispenses drugs in containers that have been labeled by the machine itself.

The suggestion/motivation would have been to incorporate a will-call vending machine, as taught by Bain, which allows patients to pick up prescriptions while the

pharmacy is busy or closed, into a network of drug vending machines. See Bain, paragraph 2.

One ordinarily skilled in the art would have been further led to combine Bain with Hart because Hart's system endeavors to "provide a convenient, safe, automated, and low cost drug delivery system..." See Hart, col. 1, line 64-col. 2, line 6 and col. 2, lines 20-23. Bain's system adds to the cost savings and efficiency of Hart's integrated system.

Response to Arguments

8. Applicant's arguments filed 7/10/07 have been fully considered but they are not persuasive. Applicant's newly added claim limitations where "the customer request include[s] a one-time use, unique code, which is incapable of being reused", are recited in Claims 1, 13 and 21. Claim 17 also recites "a one-time, unique code". As discussed above, Bain discloses use of a "personal pin number" at paragraph 111. Applicant asserts that the patient's personal identification number (PIN) is clearly capable of being reused. However, it is also capable of not being reused if the use so intends by simply not using it.

If the customer uses Bain's machine once each day and changes the pin periodically, such as after each use, the customer will then have a new pin number each day and after each use. Applicant's claim language does not indicate any structure that causes the unique code, i.e., the pin number, to be rendered incapable of being used a second time. Also, the phrase "which is incapable of being reused" is considered intended use language, which does not carry patentable weight. Thus, Applicant's

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claim language in Claims 1, 13 and 21 directly read on Bain's disclosed pin number that a customer uses to access his prescriptions in Bain's machine.

In Claims 16 and 28, Applicant refers to a "first location" in which filled containers are held, and a second location in which the containers are released from the first location for customer pickup. Applicant's first location reads on Bain's dispensing portion (112). Applicant's newly added claim language referring to a "second location" in Claims 16 and 28 reads on Bain's dispensing trough (140) as discussed at paragraph 67.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey A. Shapiro
Examiner
Art Unit 3653

December 8, 2007